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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/829,595

04/22/2004

Cesar A. Galindo-Legaria

MSFT-3957/160078.02

6876

41505

7590

12/23/2008

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EXAMINER

MIZRAHI, DIANE D

ART UNIT

PAPER NUMBER

2165

MAIL DATE

DELIVERY MODE

12/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/829,595	Applicant(s) GALINDO-LEGARIA ET AL.	
	Examiner DIANE MIZRAHI	Art Unit 2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-41, 43-45, 47-51, 53-57 and 67-96 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-41, 43-45, 47-51, 53-57, and 67-96 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 39-41, 43-45, 47-51, 53-57, and 67-96 are currently pending in the subject application and are presently under consideration. Claims 1-38, 42,46,48,52, and 58-66 are canceled.

This office action is in response to the newly submitted amendment filed September 8, 2008. The amendment of 9-8-2008 to the specification and claims have been entered in Applicant's specification. Examiner maintains the rejection of Claims 39-41,43-45, 49-51, 53-57 and 67-96 under 35 USC 101 and the double patenting rejection. See below:

Claims Rejections – 35 U.S.C. 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 39-41,43-45, 47, 49-51, 53-57, 67-96 are rejected under 35 U.S.C. 101, because the claimed invention is directed to non-statutory subject matter.

Claims 39-41,43-45, 47, 49-51, 53-57 recites "*a computer implemented method*".

However, nothing in the disclosure of the present invention indicates that the recited "computer implemented method " necessarily includes hardware. Accordingly, the "*method*" recited in Claims 39-41,43-45, 47, 49-51, 53-57 are software *per se*.

Computer software is not a process, a machine, a manufacture or a composition of matter. Accordingly, Claims 39-41,43-45, 47, 49-51, 53-57 fails to recite statutory subject matter, as defined in 35 U.S.C. 101.

Claims 67-96 recites "a computer readable media" which, according the amended specification of September 9, 2008 of the instant Application may include

- - Computer 110 typically includes a variety of computer readable media. Computer readable media can be any available media that can be accessed by computer 110 and includes both volatile and nonvolatile media, removable and non-removable media. By way of example, and not limitation, computer readable media may comprise computer storage media and communication media. Computer storage media includes both *volatile and nonvolatile, removable and non-removable media* implemented in any method or technology for storage of information such as computer *readable instructions, data structures, program modules or other data*. Computer storage media includes, but is not limited to, RAM, ROM, EEPROM, flash memory or other memory technology, CDROM, digital versatile disks (DVD) or other optical disk

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storage, magnetic cassettes, magnetic tape, magnetic disk storage or other magnetic storage devices, or any other medium which can be used to store the desired information and which can be accessed by computer 110. Communication media typically embodies computer readable instructions, data structures, program modules or other data - - .

Combinations of any of the above should also be included within the scope of computer readable media." Appropriate action is required.

In the interest of compact prosecution, the application is further examined against the prior art, as stated below, upon the assumption that the applicants may overcome the above stated rejections under 35 U.S.C. 101.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 43-45, 47, 50-51 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 102-106, and 108-109 of copending Application No. 10/998,761. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The mapping of the claims is listed below:

Current Application 10/998,876	US Application 10/852,595
Claims 102-106,108-109:	Claims 43-45 and 49-51:
Claim 102	Claim 43
Claim 103	Claim 44
Claim 104	Claim 45
Claim 105	Claims 47 and 49
Claim 106	Claim 47
Claim 108	Claim 50
Claim 109	Claim 51

Examiner's note to the Applicant: According to MPEP (2111.02 [R-3] - Effect of Preamble), "The determination of whether a preamble limits a claim is made on a case-by- , case basis in light of the facts in each case; there is no litmus test defining when a preamble limits the scope of a claim. Catalina Mktg. Int '1 v. Coolsavings.com, Inc., 289 F.3d 801,808, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002). See id. at 808-101 62 USPQ2d at 1784-86 for a discussion of guideposts that have emerged from various decisions exploring the preamble's effect on claim scope, as well as a hypothetical example illustrating these principles."

"[A] claim preamble has the import that the claim as a whole suggests for it." Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." Pitney Bowes, Inc. v. Hewlett- Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999).

Allowable Subject Matter

Claims 39-41, 43-45, 47, 49-51, 53-57 and 67-96 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101 and double patenting rejection, set forth in this Office action for reasons set forth in the office action of January 8, 2008. The record is clear as to the reasons for allowance. Accordingly, no additional statement is necessary.

Applicant is invited to further amend the claims to overcome the prior art made of record. Examiner asserts that the prior art made of record teaches Applicant's claimed invention. At this time, the claims are not allowable over the prior art made of record.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the rejection above and the rejection stated in this office action.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane D. Mizrahi whose telephone number is 571-272-4079. The examiner can normally be reached on Monday-Thursday (9:30 - 4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian Chase can be reached on (571) 272-4190. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 305-3900 for After Final communication.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

/Diane Mizrahi/

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December 10, 2008